

### **III. REMARKS**

#### **Status of the Claims**

Claims 8 is canceled, claims 1 and 13 are amended and new claims 15 and 16 are added. Claims 1-7, and 9-16 are presented for further consideration.

#### **Summary of the Office Action**

Claims 1-14 stand rejected under 35USC102(a) on the basis of the cited reference Chikano, WO/00/21155. Claims 2-6,8, and 14 stand rejected under 35USC103(a) on the basis of the cited reference Chikano in view of the reference Nakimi Corporation. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Applicant submits that the amendments to claims 6 and 13 and the cancellation of claim 8 submitted above fully overcome the rejections based on 35USC112.

#### **Discussion of the Cited Reference**

The Examiner has cited the reference Chikano in support of the rejection based on anticipation. The reference Chikano describes a motor driven means for extending and retracting an antenna of a portable telephone. The movement of the antenna is triggered by operation of a call button. This is concisely described on page 1, lines 23-28 as follows:

"The invention in claim 1 is a portable telephone set comprising a main body, an antenna appended to the main body so as to be extendible or collapsible with respect to the main body, and a control panel mounted on an external surface of the main body, wherein when a call is set up via operation of the control panel, the antenna is extended from

the main body, and when the call is terminated via operation of the control panel, the antenna is collapsed into the main body."

The claims of this application, as amended, are directed to the operation of a cover element which at least partially covers the user interface of a mobile telephone by means of a motor driven transmission. There is nothing in the cited reference Chikano with regard to the movement of a cover element.

### **The Issue of Anticipation**

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the system of the reference Chikano it becomes clear that the system of Chikano is missing significant elements of independent claims 1 and 13. There is no provision in the antenna system of Chikano for opening and closing a cover of a mobile telephone by a motor driven transmission. Claim 1 states:

"a first cover element which is moveable, relative to said user interface, between a first position in which a part of the user interface is covered and a second position in which that part of the user interface is uncovered;"

"converting means for converting the rotational movement into a movement of the first cover element..."

Equivalent language also is contained in claim 13. Since these elements form no part of the system of Chikano, there would be no infringement, if Chikano was later, therefore, the cited reference Chikano does not support the rejection by the Examiner based on anticipation.

The above arguments are equally applicable to the rejected dependent claims.

The Examiner has also rejected claim 2-6,8 and 14 based on the cited reference Chikano in view of the applicant's cited reference to Namiki Corporation motors. Applicant submits that this rejection is untenable in view of the total lack of disclosure in Chikano of a cover operating mechanism. The only link between the use of a Namiki type motor and a cover operating mechanism for a mobile phone is the subject application.

Applicant suggests that an element of hindsight tarnishes the Examiner's position. The court has stated the following in such instances:

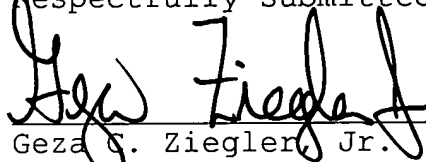
In short to "imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. "W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303,312 (CAFC 1983).

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should

any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check for \$110 is enclosed for a one-month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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16 September 2004  
Date

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